

Appl. No. : **10/065,120**
Filed : **September 18, 2002**

REMARKS

Reconsideration and allowance of the above-referenced application are respectfully requested.

Claims 1, 2, 9-13, 15, 17-20, 23-27 and 51-52 stand rejected under 35 USC 112, first paragraph, as allegedly not supporting the claimed subject matter. This contention is respectfully traversed. Moreover, in order to obviate many of the rejections to the breadth of the word testing, the claims are amended herein to better explain that word.

As an initial matter, applicants would like to review the chronology of this case, responsive to the statement in the rejection that the present claims were based on non-elected subject matter. At a previous point within the prosecution, claims 4-7 were indicated as allowable. Since these were allowable claims, applicant believed that these claims had been examined by the examiner, and that any issue of restriction must have been waived. Accordingly, applicant attempted to rewrite the claims in a way that would obviate the prior art based rejections in the application, by accepting claims that the patent office itself indicated were allowable. The undersigned apologizes to the extent that this may have caused extra work to the patent office - but again, this was based on the patent office's own indication that these claims were allowable.

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However, based on the fact that a new office action has been received on the merits of these new claimed subject matter is, it is believed that the patent office has now reconsidered and/or waived any previous restriction requirement on these grounds.

Responsive to the rejections under section 112, the testing part, is clearly disclosed in paragraphs 14-15 of the originally-filed specification. This section discloses a test module that can be used to test a degree of privacy. The test module can connect to the server and can obtain an evaluation of the degree of position blocking.

The rejection states that there is no enablement for a testing part, but the test module clearly meets this limitation. Paragraph 15 explains that this tests the operation of the security. Similarly, the "testing part" throughout these claims, quite clearly is met by paragraphs 14-15.

The rejection also objects that there is no physical privacy control. However, this is clearly disclosed, paragraph 11 last four sentences, which explains that there is a privacy mode, which prevents the position detector from reporting its position. In any case, this contention has been obviated, for the most part, with respect to many of the amended claims.

With all due respect, therefore, it is respectfully suggested that each of these rejections are in the error and should be withdrawn.

Claims 1, 2, 9-13, 15, 17-20, 23-27 and 51-52 stand rejected under 35 USC 112, first paragraph, as allegedly failing to comply

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with the written description requirement. The support for the testing part was explained above.

The rejection further contends that claim 9 is new matter since the specification does not disclose testing the communication. Paragraphs 14 and 15 disclose testing the operation of the privacy. In fact, the last line of paragraph 14 explains that the test module can "evaluate the privacy...". Clearly, therefore, there is clear antecedent and support for this subject matter.

Amendments are submitted herewith to further emphasize this patentable subject matter. For example, claim 52 has been amended to clarify that the reporting device is part of the communication electronics.

Claims 1, 2, 9, 10-13, 15, 17-19, 24-27 and 52 are rejected under 35 USC 112, second paragraph, as allegedly being indefinite. In response, these claims are amended here with for definiteness.

Claims 1, 2, 4-7, 9, 10, 13, 17-20, 23-27 and 51 stand rejected under 35 USC 103a as allegedly being unpatentable over Zellner in view of Simms and Mohan. It is believed that the rejection was based on breadth of the word "testing". The claims are amended herewith to further emphasize the meaning and function of the term "testing". It is believed that these amendments obviate this rejection, for reasons set forth herein.

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Zellner teaches a basic location blocking service for a wireless network. As admitted by the official action, Zellner does not disclose a testing part.

The secondary reference to Simms has a test button that initiates a self test of the device. Therefore, the rejection reasons that the hypothetical combination could provide a self test.

The tertiary reference to Mohan discloses testing operation and validity of operation of the communicated message that includes position information. Mohan teaches a test of communication, and also teaches E-911.

Therefore, the hypothetical combination might teach a Zellner type system with the ability to test communication information, coupled with a self test system as in the Simms reference and with a communication test as in Mohan.

However, there is no teaching or suggestion of testing whether the position detection has actually been prevented from reporting its position, as claimed by claims like claim 1, or other similar important features defined by other claims. Therefore, the important feature of a these claims is not disclosed by the cited prior art.

The rejection states that operation of the testing function during the privacy mode would obviously be a desired function to be tested. However, this conclusion is entirely based on hindsight - and this conclusion is made possible only based on the teaching of the present specification. Communication might

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be tested as taught by the prior art. However, no one, prior to the present application, ever realized that position privacy controls might be hackable. The normal expectation might be that once you initiate position privacy (e.g., in the language of claim 1, "prevent[] said position detection module from reporting its position", that the position reporting is really blocked.

The unobvious part of the present invention is - what if the system has been hacked - and someone could actually track you even after you thought you had prevented the reporting of position? No one has suggested that this problem could even exist, much less suggested a solution to the problem. So, here, as in *EIBEL PROCESS CO. v. MINNESOTA & ONTARIO PAPER CO.*, 261 US 45 (1923), part of the patentable advance is the discovery of the problem itself: specifically of testing against hacking or otherwise defeating the position reporting security part (e.g., using the words of claim 1). No one has ever suggested testing this, and in fact, no one has even ever suggested that there is a problem that could be tested in this way.

Claim 1 defines, therefore, a testing part that "carries out at least one test that forms a result, that result having data that indicates if said security part is actually preventing said position detection module from reporting its position". As described above, nothing in the prior art has ever even suggested that such a test would even be necessary or desirable. No prior art had ever even suggested the source of the problem that is

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being solved here. Accordingly, the shows clear unobviousness of the currently claimed testing.

Moreover, consider the so-called *KSR* factors, set forth in Federal Register volume 72 number 195. None of these factors would be a proper basis for rendering obvious claim 1 (or the other claims herein).

Rationale A is combining prior art elements according to known methods to yield predictable results. As described above, there are no known methods for combining these prior art elements: the source of the problem was not known prior to the disclosure in this application. In any case, even if the prior art is combined as suggested by the official action, nothing in this hypothetical combination of prior art suggests a test that forms a result that indicates if the security part is actually preventing the position detection module from reporting its position as claimed.

Rationale B is substitution of one known element for another to obtain predictable results. Here, there is nothing predictable about the results, and in any case no substitution could possibly lead to these results.

Rationale C is use of knowing techniques to improve similar devices in the same way. Here, the prior art shows communication devices and position reporting devices. The known techniques use self test of communications systems, and other similar systems. There is nothing that suggests the claimed specific way of

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improving the operation of the device: quite simply this is a new way of improving the device not suggested or disclosed by the cited prior art.

Rationale D is applying a known technique to a known device to yield predictable results. The devices here are not known, and the result is not predictable: the source of the problem, in fact, was not known before the disclosure thereof by the applicant.

Rationale E - obvious to try - is inapplicable since there are not here a finite number of identified predictable solutions.

Rationale F is known work in one field being applicable to another field. Here, there is a new problem, not suggested by the prior art, and no showing that any problem in any other field could be applied to this field.

Rationale G is the teaching, suggestion, or motivation test. Here, there is no teaching, suggestion or motivation of this system in the prior art.

For all of these reasons, it should be seen that the present system is wholly unobvious based on the cited prior art and that claim 1 should be allowable along with the claims that depend therefrom.

The other claims should be similarly allowable.

Claim 4 defines testing the cellular phone to determine whether the position is actually being prevented from being reporting. The nonobviousness of this feature has been discussed above, and claim 4 should hence be allowable for these reasons.

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Claim 5 defines that the testing uses a network-based service to test whether the position is being reported, and that the test "is initiated from a remote location over the same communication channel that is used for said cellular communication". Nothing in the prior art discloses or suggests this kind of test, over this kind of channel, for this purpose. In fact, as discussed above, this test is not at all predictable from the prior art.

Claim 6 defines that a network-based service updates the software, and claim 7 defines that information indicative of new techniques of causing the position to be reported while in the second privacy enhanced mode is updated. None of the cited prior art is in any way suggestive of this kind of upupdating, and claim 7 should hence be further allowable.

Claim 9 defines a testing part that carries out a test which determines if the position privacy control has successfully prevented the position detection module from reporting its position. For reasons discussed above, this is not disclosed by the prior art and not obvious thereover.

Claim 10 defines that the testing part provides information from a remote source accessed using the communicating electronics, the information being used to test the privacy of the communicating electronics. None of the cited prior art teaches or suggests or makes obvious such a system. The dependent claims should be allowable for reasons discussed above.

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Claim 20 defines a testing part to communicate with a remote location, the nonobviousness of which has been disclosed in detail above.

The rejection of dependent claims 11, 12, 15 and 52 based on Zellner in view of Simms and Mohan and Roeder or Altidor is incorrect for similar reasons to those discussed above.

Many of these claims stand alternatively rejected as being anticipated by Moles. This contention has been obviated by the amendments of the claims to obviate the broad interpretation of the word "test". In fact, Moles only tests the privacy by showing whether location blocking is overridden or not overridden, there is no actual determination of actually testing anything other than whether the setting is on or not.

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

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For all of these reasons, it is respectfully suggested that all of the claims should be in condition for allowance. A formal notice of allowance is hence respectfully requested.

If the Examiner believes that communications such as a telephone interview or email would facilitate disposal of this case, the undersigned respectfully encourages the Examiner to contact the undersigned.

Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me concerning any subject matter of this application by electronic mail (using the email address scott@harrises.com). I understand that a copy of these communications will be made of record in the application file.

Please charge any fees due in connection with this response, (including the second month extension of time paid via EFS), to Deposit Account No. 50-1387, small entity.

Respectfully submitted,

Date: _12/26/07_____

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